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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/983,041	10/22/2001	Atsushi Shibuya	PF-2894/NEC/US/mh	8200
30743	7590	12/09/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			NGUYEN, HAI V	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/983,041

Applicant(s)

SHIBUYA, ATSUSHI

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,31-38,40-47 and 49-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,31-38,40-47 and 49-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the communication received on 22 September 2005.
2. Claims 30, 39, 48 are cancelled.
3. Claims 1-29, 31-38, 40-47, and 49-55 are presented for examination.

Response to Arguments

Applicant's arguments filed on 22 September 2005 have been fully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground(s) of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., a plurality of terminal devices connectable to said communication network for transmitting and receiving an information item through said communication network; wherein said communication system includes a table which provides at least one retrieval condition and for each said retrieval condition at least one corresponding display method, so as to enable said terminal devices to detect in said information item said at least one retrieval condition and if the retrieval condition is detected to display said information item in accordance with said at least one corresponding display method, in independent claims 1, 16, 29, 38, and 47) to the claims which significantly affected the scope thereof.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-29, 31-38, 40-47, and 49-55 are rejected under 35 U.S.C. 103(a) as obvious over **Jones** U.S. patent application publication # **2001/00460069 A1** in view of Kuboh et al. U.S. patent # **5,948,058**.

6. As to claim 1, Jones taught the invention substantially as claimed (e.g., as in exemplary claim 1) including a communication network (*Fig. 3, Internet*); and a plurality of terminal devices (*Fig. 3, user terminals 301*) connectable to said communication network for transmitting and receiving an information item through said communication network; wherein said communication system includes a table which provides at least one retrieval condition (*Fig. 1, confidential 11*) and for each said retrieval condition at least one corresponding display method, so as to enable said terminal devices to detect in said information item (*Fig. 1, email*) said at least one retrieval condition (*Fig. 1, confidential 11, or proprietary, or watermark*) and if the retrieval condition is detected to display said information item in accordance with said at least one corresponding display method (*Figs. 1-3, electronic mail systems generally allow images (i.e., pictures) or sound bites to be embedded into and form part of a message. For example, a message*

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can contain a "stamp" with the word "confidential" or a message can contain a sound clip with the word "confidential". An image or sound clip that forms part of an electronic message can carry a digital watermark that can be detected and read by conventional watermark programs, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]).

It would have been obvious to one of ordinary skill in the networking art at the time of the invention that the claimed invention differed from the teachings of Jones only by a degree, e.g., the table having retrieval conditions and corresponding display method which is taught by **Kudoh** (patent # **5,948,058**) in Fig. 32 for the purpose of displaying email classification types (*Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

7. As to claim 2, Jones-Kuboh discloses, wherein each retrieval condition in said table comprises a key object (*Jones, digital watermark*).

8. As to claim 3, Jones-Kudoh discloses, wherein each said key object comprises at least one object selected from the group consisting of key words and key marks (*Jones, confidential, proprietary, digital watermark*).

9. As to claim 4, Jones-Kudoh discloses, wherein said table includes designating data which designate necessary data for displaying said information item in accordance with said at least one corresponding display method (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

10. As to claim 5, Jones-Kudoh discloses, wherein said table includes necessary data for displaying said information item in accordance with said at least one corresponding display method (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

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11. As to claim 6, Jones-Kudoh discloses, wherein said table is editable (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

12. As to claim 7, Jones-Kudoh discloses, wherein said table is transferable through said communication network (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

13. As to claim 8, Jones-Kudoh discloses, wherein said information item comprises an e-mail (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

14. As to claim 9, Jones-Kudoh discloses, wherein said e-mail has at least an attached file (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

15. As to claim 10, Jones-Kudoh discloses, wherein said table is stored in a memory of said terminal device (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

16. As to claim 11, Jones-Kudoh discloses, wherein said table is open on a server computer on said communication network, so as to enable said terminal device to download said table from said server (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

17. As to claim 12, Jones-Kudoh discloses, wherein each of said terminal devices includes:

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a first function block for performing said retrieval under said retrieval condition with reference to said table (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*); and

a second function block for displaying said information item in accordance with said at least one corresponding display method (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

18. As to claim 13, Jones-Kudoh discloses, wherein each of said terminal devices further includes: a third function block for transmitting and receiving said table through said communication network (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

19. As to claim 14, Jones-Kudoh discloses, wherein each of said terminal devices includes:

a processing unit; and

a memory accessible by said processing unit, and said memory storing a computer program comprising the steps of means for performing said retrieval under said at least one retrieval condition with reference to said table; and means for displaying said information item in accordance with said at least one corresponding display method (*Jones, page 1, paragraph [0006]; page 2, paragraphs [0016]-[0024]; Kudoh, col. 18, lines 51-60; col. 27, lines 16-52*).

20. As to claim 15, Jones-Kudoh discloses, wherein said computer program further comprises means for transmitting and receiving said table through said communication

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network (*Jones, page 1, paragraphs [0006]-[0008]; Kudoh, col. 3, line 30 – col. 9, line 45*).

21. Claim 16 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

22. Claims 17-24 have similar limitations of claims 2-9; therefore, they are rejected under the same rationale as in claims 2-9.

23. Claims 25-28 have similar limitations of claims 12-15; therefore, they are rejected under the same rationale as in claims 12-15.

24. Claim 29 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

25. Claims 31-37 have similar limitations of claims 2, 4-9; therefore, they are rejected under the same rationale as in claims 2, 4-9.

26. Claim 38 corresponds to the method claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

27. Claims 40-46 have similar limitations of claims 2-9; therefore, they are rejected under the same rationale as in claims 2-9.

28. Claim 47 corresponds to the computer readable medium claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

29. Claims 49-55 have similar limitations of claims 2-9; therefore, they are rejected under the same rationale as in claims 2-9.

30. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

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Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
Art Unit 2142



THONG VH
Primary Examiner
